

REMARKS

Claims 1 and 4-10 are pending in this application. Claims 1 and 4 have been amended.

Claims 2, 3, and 11-24 have been cancelled.

In the Office Action, claims 1-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,867,649 (Kawashima) in view of U.S. Patent No. 6,065,343 (Kiuchi et al.). Claims 1-24 are provisionally rejected on the grounds of nonstatutory obviousness-type patenting as being unpatentable over claims 10-11 of U.S. Copending Application No. 10/300,590, Pub. No. US2003/0123769 (Ohki), in view of Kawashima. Claims 1-24 are also rejected on the grounds of nonstatutory obviousness-type patenting as being unpatentable over claim 1 of U.S. Patent 7,296,933 (Tsujimoto) in view of Kawashima. These rejections are respectfully traversed. Applicants hereby request reconsideration and allowance of the claims in view of the following arguments.

Regarding the rejection of independent claims 1 and 4, these claims have been amended to incorporate the limitations of claims 2, 3, 11, and 18, respectively. Claims 2, 3, 11, and 18 have consequently been cancelled. Amended independent claims 1 and 4 thus recite a compressor bearing component (claim 1) or a compressor bearing member (claim 4) having an austenite grain with a grain size number falling within a range exceeding 10, *a fracture stress value of at least 2650 MPa, and a hydrogen content of at most 0.5 ppm*. These amendments are fully supported, for example, in original claims 2, 3, 11, and 18; and at p. 14, lines 10-28 and page 19, Table 1 of the present application. No new matter has been added.

In the Office Action, the Examiner contends that the recited fracture stress value of claims 2 and 11, and the recited hydrogen content of claims 3 and 18, which subject matter is now contained in amended independent claims 1 and 4, are inherent in the disclosure of the prior

art. However, there is not legally adequate support in the Office Action for this contention. Therefore, the Examiner has not met their burden of establishing inherency, despite contentions to the contrary at page 3 of the Office Action.

It is well-established that the Examiner must provide a rationale or evidence tending to show inherency. *See, MPEP 2112*. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijchaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Moreover, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the Office Action, the Examiner’s only support for the conclusion of inherency of the claimed features in Kawashima or Kiuchi is “[t]here is reasons to believe, base on the similarity of (structure, etc.) that the functional limitation(s) of the fracture value being 2650 MPa and the hydrogen content of 0.5 ppm restricted is (an) inherent characteristic(s) of (the prior art).” This perfunctory statement is purely speculative, and cannot establish inherency under the legal standards set forth in section 2112 of the **MPEP**. For example, what “similarity of structure” is the Examiner referring to between the claimed invention and Kawashima or Kiuchi? How does such a similarity lead to the conclusion that Kawashima *necessarily* has the claimed hydrogen

content and fracture stress characteristics? Where is the statement of facts and/or scientific principles upon which the Examiner is basing the conclusion of inherency?

For example, the claimed features of an austenitic grain size number exceeding 10, a fracture stress value at least 2650 MPa and a hydrogen content of at most 0.5 ppm cannot be inherent in the Kiuchi reference, because a material that meets all these conditions can be obtained only by the heat treatment method shown in Figs. 2 or 3 of the present application. Kiuchi does not disclose or suggest such a heat treatment. Specifically, Kiuchi does not disclose or suggest a heat treatment wherein the temperature is set lower than the A1 transformation point between the primary and secondary quenching.

The claimed features of a fracture stress value at least 2650 MPa and a hydrogen content of at most 0.5 ppm are not disclosed or suggested in either Kawashima or Kiuchi. Moreover, there is not a reasonable assertion of inherency in the Office Action. Consequently, the Examiner has not made out a *prima facie* case of obviousness. Since the PTO has not met its burden of establishing a *prima facie* case of obviousness by stating a reasonable assertion of inherency, the burden of proof of disproving inherency has not shifted to the Applicants, and the obviousness rejection should be withdrawn.

Regarding the provisional obviousness double-patenting rejection of claims 1-24 based on Ohki and Kawashima, this rejection is traversed because the Examiner relies on the inherency of at least the limitations of claims 2 and 11 in Ohki and/or Kawashima for support. As discussed hereinabove, the Examiner has not shown the inherency, in Kawashima, of the claimed features of claims 2 and 11 of a fracture stress value at least 2650 MPa, much less the combination of the claimed fracture stress value *and* a hydrogen content of at most 0.5 ppm, as

recited in amended claims 1 and 4. Likewise, the Examiner has not offered any evidence to show the inherency of these claimed features in Ohki. Since these features are found in amended independent claims 1 and 4, the Examiner has not made out a *prima facie* case of obviousness of claims 1 and 4 based on Ohki and Kawashima, and this rejection should be withdrawn.

Regarding the obviousness double-patenting rejection of claims 1-24 based on Tsujimoto and Kawashima, this rejection is traversed because the Examiner relies on the inherency of the limitations of claims 2, 3, 11, and 18 in Tsujimoto and/or Kawashima for support. As discussed hereinabove, the Examiner has not shown the inherency, in Kawashima, of the claimed features of claims 2, 3, 11, and 18 of a fracture stress value at least 2650 MPa and a hydrogen content of at most 0.5 ppm. Likewise, the Examiner has not offered any evidence to show the inherency of these claimed features in Tsujimoto. Since these features are found in amended independent claims 1 and 4, the Examiner has not made out a *prima facie* case of obviousness of claims 1 and 4 based on Tsujimoto and Kawashima, and this rejection should be withdrawn.

Consequently, amended claims 1 and 4 are patentable, as are claims 5-10, which depend from claim 4.

Accordingly, it is believed that the application is now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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